

REMARKS

In response to the Office Action mailed May 12, 2009, Applicant hereby requests reconsideration of the rejections based upon the above claim amendments and these remarks. Claims 1-7 were last presented for examination, of which all were rejected, with the following issues being raised:

1. Claims 1-7 were rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter;
2. Claims 1 and 6 were rejected under 35 U.S.C. § 102(a) as anticipated by U.S. Patent No. 5,984,193 to Uhling;
3. Claims 2-4 and 7 were rejected under 35 U.S.C. § 103(a) as being obvious over Uhling in view of U.S. Patent No. 5,619,027 to Ackley; and
4. Claim 5 was rejected under 35 U.S.C. § 103(a) as being obvious over Uhling in view of Ackley, and further in view of admissions presumed from Applicant's disclosure.

Following the above amendments to the claims, claims 1-7 remain pending in the application, with claim 1 remaining as the sole independent claim.

Rejections under 35 U.S.C. § 101

Claim 1, as amended, recites "An optical machine-readable medium comprising a two-dimensional bar code", which is patentable subject matter under 35 U.S.C. § 101 for several reasons. As an initial consideration, according to the BPAI's recent decision in the matter of *Ex parte Mazzara*, the term "computer useable medium" was limited to only tangible manufactures, as the skilled artisan would understand the term. *Ex parte Mazzara*, No. 2008-4741, 2009 WL 291178 (BPAI Feb. 5, 2009). The same treatment applies to the optical machine-readable medium in the present application. The barcode is recited as part of the optical machine-readable medium, and the barcode imparts structure to the medium that is physical, regardless of how the barcode is generated or placed upon the medium. This structure may even be in the form of ink on paper (which is not a limitation of the claimed subject matter), but since even such a structure is not in the form of human readable printing, it does not fall within the prohibition against printed matter indicated in MPEP 2106.01 II.B. The claimed optical machine-readable medium is therefore a manufacture which is patentable subject matter.

This conclusion is further supported by the non-binding “Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101”. Section II.B. of those instructions provide an example of statutory subject matter:

(c) As another example, a claim to a non-transitory, tangible computer readable storage medium *per se* that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture would be patent-eligible subject matter.

According to this example, if a claimed computer readable medium is non-transitory and possesses structural limitations, then it is patentable subject matter. In the present application, the barcode provides structural limitations to the optical machine-readable medium. Barcodes are known as and have long been recognized as physical structures. The standard definition of a barcode, pulled from the undersigned’s desk reference dictionary, supports the view that a barcode is a physical structure on a medium:

a machine-readable code in the form of numbers and a pattern of parallel lines of varying widths, printed on and identifying a product.

Even though this definition indicates that a barcode is printed on the medium, as indicated above, since the printed material is not human readable, the medium with the barcode qualifies as patent-eligible subject matter.

The Office Action takes the viewpoint that the claimed subject matter is “nonfunctional descriptive material”, as opposed to the proper classification as a manufacture. However, even if the barcode is considered “descriptive material”, it would be properly classified functional descriptive material. The Office Action clearly indicates that the barcode is a data structure. This data structure, when combined with an optical machine-readable medium, permits the functionality of the barcode as a data structure to be realized when employed as a computer component. (MPEP 2106.06.) The machine readable barcode is therefore properly classified as “functional descriptive material”. Moreover, the machine readable barcode is wholly different from a non-patent eligible abstract idea, such as music, literature, art, a photograph, or a mere arrangement or compilation of facts or data. (See MPEP 2106.01 II.B.) Finally, if the barcode is considered functional descriptive material, and it imparts functionality that is realized through use of the machine-readable medium with a computer, then the barcode is viewed as being

“structurally and functionally” interrelated with the medium. (MPEP 21.06.06.). For this reason, the claimed subject matter is necessarily patent-eligible.

Rejections under 35 U.S.C. § 102

Claim 1 was rejected as anticipated by Uhling. In order to serve as a basis for an anticipation rejection, a cited reference must disclose each and every claim limitation. As amended, claim 1 recites “an encoding information sequence is disposed sequentially in two dimensions on said nodes of said matrix in one direction and in a reversible order”, but Uhling does not disclose this limitation. In particular, Uhling does not disclose disposing the sequence in two dimensions and in a reversible order as it relates to a two-dimensional bar code. As is shown quite clearly in Fig. 3 of Uhling, the information sequence is encoded twice in the two-dimensional barcode, once in a row, and again in a column. Thus, Uhling discloses nothing more than encoding each information sequence along a single dimensional path, with each sequence being encoded in both a row and a column to generate a two-dimensional barcode. It does not disclose the information sequence being disposed in both a plurality of rows and a plurality of columns, an example of which is shown in Figs. 2A and 2B of the present application. Uhling therefore does not disclose an encoding information sequence “disposed sequentially in two dimensions”. As such, Uhling does not anticipate amended claim 1.

Claim 6, a method claim, was also rejected as anticipated by Uhling. Claim 6 incorporates all the limitations of amended claim 1, and as such, where Uhling does not anticipate amended claim 1, it also does not anticipate amended claim 6.

Rejections under 35 U.S.C. § 103

Claims 2-5 and 7 were rejected as obvious over Uhling in view of at least Ackley. Each of these claims ultimately depends from claim 1 or claim 6. As indicated above, Uhling does not teach all the limitations of amended claim 1. Further, neither Ackley nor the presumed admissions identified in the Office Action fill in the gaps in the teachings of Uhling. As such, the cited combinations do not render any of claims 2-5 and 7 obvious.

Conclusion

For the foregoing reasons, Applicant requests reconsideration of the rejections.

A 1 month extension of time is hereby requested pursuant to 37 C.F.R. §1.136(a), for which the appropriate fee is submitted herewith. The undersigned believes no additional extensions or fees are due with this response. However, if an additional extension is needed or a fee is due, please consider this a request therefor and charge Deposit Account No. 03-2775, under Order No. 13836-00002-US, from which the undersigned is authorized to draw.

Dated: September 14, 2009

Respectfully submitted,

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